

REMARKS

In the Final Office Action¹ mailed December 7, 2010, the Examiner:

- 1) objected to claims 47-69 because "computer readable medium" allegedly no longer satisfies statutory requirements;
- 2) rejected claims 70-92 under 35 U.S.C. § 112, sixth paragraph for allegedly failing to clearly link or associate the disclosed structure, material, or acts to the claimed function;
- 3) rejected claims 1-14, 16, 17, 20, 22-37, 39, 40, 43, 45-60, 62, 63, 66, 68-84, 85, 86, and 89-92 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2003/0101148 ("*Montgomery*") in view of U.S. Patent No. 6,772,130 ("*Karbowski*");
- 4) rejected claims 19, 42, 65, and 88 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* and *Karbowski* in further view of U.S. Patent No. 6,385,504 ("*Pintsov*"); and
- 5) rejected claims 15, 18, 21, 38, 41, 44, 61, 64, 67, 84, 87, and 90 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* and *Karbowski*, in further view of Official Notice.

By this response, Applicant has amended claims 1, 12, 24, 35, 47, 58, 70, 78, 79, 81-85, 87-89, and 91. No new matter has been added. Claims 17, 40, 63, and 86 have

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

been cancelled without prejudice or disclaimer. Claims 1-16, 18-39, 41-62, 64-85, and 87-92 are pending and under examination.

Objection to Claims 47-69

The Final Office Action objected to claims 47-69 because “computer readable medium no longer satisfies statutory requirement” and advised the Applicant to revise the term to “non-transitory computer readable medium.” O.A. at 2. Applicant respectfully submits that the term “computer readable medium” is not itself outside of the statutory requirements for 35 U.S.C. § 101, but only when the claims are directed towards a transitory propagating signal per se. Although Applicant traverses the objection, to advance prosecution, Applicant has amended independent claim 47 to recite a “non-transitory computer readable medium.” Claims 48-62 and 64-69 depend from independent claim 47. Therefore, the claims cannot cover a transitory propagating signal per se, and the claims recite statutory subject matter.

While Applicant recognizes that the January 26, 2010, U.S. Patent and Trademark Office memorandum identifies “non-transitory” as one way to overcome a § 101 rejection directed to a signal, Applicant respectfully submits that other avenues also exist. Applicant submits that a signal is not a tangible medium. For at least these reasons, Applicant respectfully requests the Examiner withdraw the objection to claims 47-69. Applicant notes that the objection to claim 63 has been rendered moot by its cancellation.

Rejection of Claims 70-92 under 35 U.S.C. § 112, Sixth Paragraph

The Final Office Action rejected claims 70-92 as means plus function limitations where the written description allegedly fails “to clearly link or associate the disclosed

structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function.” O.A. at 2. Although Applicant traverses the rejection, to advance prosecution, Applicant has amended claim 70 so that it no longer recites means plus function language invoking 35 U.S.C. § 112, sixth paragraph. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection of claim 70 and its dependent claims 71-92 under § 112, sixth paragraph. Applicant notes that the rejection of claim 86 has been rendered moot by its cancellation.

Rejections of Claims 1-92 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-92 under 35 U.S.C. § 103(a) as being unpatentable over *Montgomery* in view of *Karbowski* or over *Montgomery* and *Karbowski* in further view of *Pintsov* or Official Notice. The rejection of claims 17, 40, 63, and 86 have been rendered moot by their cancellation. A *prima facie* case of obviousness has not been established for amended claims 1-16, 18-39, 41-62, 64-85, and 87-92.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 8 (July 2010)(internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P.

§ 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the cited references and Official Notice fail to teach or suggest all the elements of independent claim 1, as amended. Amended claim 1 recites, among other things:

obtaining, by the computer system, data from the item,
wherein the data comprises a size and a weight of the item;

obtaining, by the computer system, data from a verification
database using the verification data as an index, wherein the
data is distinct from the verification data and comprises an
amount of the received payment;

verifying, by the computer system, the authenticity of the
delivery payment coding using the verification data by
comparing the amount of the received payment from the
verification database with a payment amount for the size and
the weight of the item.

Montgomery discloses using an indexing identifier to decrease the size of the postage indicium transmitted to an end user computer. *Montgomery*, Abst. *Montgomery* further discloses transmitting the indexing identifier to an end user computer, and the end user computer printing the identifier on a label that is applied to a mail piece. *Montgomery*, ¶¶ 151-152. According to *Montgomery*, the indexing identifier is read from the mail piece by a postage validation computer and used to obtain a self-validating postage indicium. *Montgomery* ¶¶ 154-155. A postal verifier then "manually compares the contents of the self-validating postage indicium to human-readable information (e.g., mailing date, postage amount, origin of mail piece, and destination of mail piece) on the mail piece." *Montgomery*, ¶ 157. *Montgomery* also discloses that the

postal verifier validates the postage indicum itself through use of a digital signature verification module. *Montgomery*, ¶ 158. "The digital signature verification submodule 898 then verifies the digital signature of the postage indicum to determine if they are consistent (step 1020). If the verification process returns a Boolean true, this indicates that the postage indicum was in fact generated by a secure central computer 356 for a mail piece of the same approximate weight, origin and destination as the mail piece being processed." *Id.*

Montgomery fails to disclose or suggest obtaining a size and a weight of the item from the item after receiving the item in an item delivery system. Because of this, *Montgomery* cannot disclose or suggest "verifying, by the computer system, the authenticity of the delivery payment coding using the verification data by comparing the amount of the received payment from the verification database with a payment amount for the size and the weight of the item."

The Final Office Action alleged that the digital signature verification process of *Montgomery* implied that the "data obtained from the item is a payment for the weight of the item and the comparing comprises comparing the payment for the weight of the item with the payment received for delivery of the item." O.A. at 6. This is incorrect. A digital signature process verifies that the encrypted digital signature matches the data used to create the digital signature. *Montgomery* teaches that the self-validating unique postage indicum contains thirteen data items and a signature. *Montgomery*, ¶ 97. "The 'Signature' is the digital signature of items 1-13." *Montgomery*, ¶ 98. Therefore, according to the digital signature verification process of *Montgomery*, once the signature is decrypted using the public key, the thirteen data items from the postage indicum are

compared with the thirteen items from the decrypted digital signature. If they match, the postage is valid, and if not the indicia has been tampered with.

While one of the items included in the digital signature disclosed by *Montgomery* is a rate code that reflects the "approximate weight, origin and destination" (*Montgomery*, ¶ 158) of a mail item, a rate code is not itself a "size or weight of the item." Indeed, as explained above, verifying a digital signature does not include obtaining a size or weight of the item for the verification process. For at least these reasons, *Montgomery* fails to disclose or suggest "obtaining, by the computer system, data from the item, wherein the data comprises a size and a weight of the item," "obtaining, by the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data and comprises an amount of the received payment," and "verifying, by the computer system, the authenticity of the delivery payment coding using the verification data by comparing the amount of the received payment from the verification database with a payment amount for the size and the weight of the item," as recited by amended claim 1.

Karowski fails to cure the defects of *Montgomery*. The Final Office Action cited *Karowski* for allegedly disclosing "updating the verification database with a time or location of the item in the item delivery system." O.A. at 4. Even assuming the Final Office Action's characterization of *Karowski* is correct, which Applicant does not concede, *Karowski* still fails to disclose or suggest "obtaining, by the computer system, data from the item, wherein the data comprises a size and a weight of the item," "obtaining, by the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data and

comprises an amount of the received payment," and "verifying, by the computer system, the authenticity of the delivery payment coding using the verification data by comparing the amount of the received payment from the verification database with a payment amount for the size and the weight of the item," as recited by amended claim 1.

Pintsov also fails to teach or suggest the above-recited elements of amended claim 1. The Examiner cited *Pintsov* as a teaching that the item delivery system comprises the United States Postal Service and that an update indicates that the verification data has been used. O.A. at 7. Assuming, without conceding, this characterization of *Pintsov*, *Pintsov* still fails to cure the deficiencies of *Montgomery* and *Karbowski*, discussed above. That is, *Pintsov*, also, fails to teach or suggest "obtaining, by the computer system, data from the item, wherein the data comprises a size and a weight of the item," "obtaining, by the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data and comprises an amount of the received payment," and "verifying, by the computer system, the authenticity of the delivery payment coding using the verification data by comparing the amount of the received payment from the verification database with a payment amount for the size and the weight of the item," as recited by amended claim 1.

Lastly, Official Notice fails to compensate for the deficiencies of *Montgomery*, *Karbowski*, and *Pintsov*. Indeed, the Final Office Action does not allege that Official Notice discloses or suggests these elements of claim 1. Moreover, Official Notice is not properly taken. In relevant part, MPEP § 2144.03 states, "[i]f the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner

must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” Applicant submits that the Examiner has made a generalized statement without any documentary evidence to support it. Applicant traverses the Examiner’s taking of “Official Notice,” noting the impropriety of this action, as the Federal Circuit has “criticized the USPTO’s reliance on ‘basic knowledge’ or ‘common sense’ to support an obviousness rejection, where there was no evidentiary support in the record for such a finding.” See, *id.* Applicant submits that “[d]efficiencies of the cited references cannot be remedied by . . . general conclusions about what is ‘basic knowledge’ or ‘common sense.’” In re Lee, 61 USPQ2d 1430, 1432-33 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicant submits that the Examiner must provide “the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicant to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made,” or else withdraw the rejection. See, MPEP § 2144.03.

Even assuming that the Official Notice is properly taken, which Applicant does not concede, Official Notice fails to cure the deficiencies of *Montgomery*, *Karowski*, and *Pintsov*, discussed above. That is, Official Notice does not disclose or suggest “obtaining, by the computer system, data from the item, wherein the data comprises a size and a weight of the item,” “obtaining, by the computer system, data from a verification database using the verification data as an index, wherein the data is distinct from the verification data and comprises an amount of the received payment,” and

"verifying, by the computer system, the authenticity of the delivery payment coding using the verification data by comparing the amount of the received payment from the verification database with a payment amount for the size and the weight of the item," as recited by amended claim 1.

In view of the above, there are significant gaps between the content of the prior art and the claimed invention. Accordingly, one of skill in the art would not have found the claimed combination obvious in view of the prior art. For at least this reason, claim 1 is not obvious over the cited art. The rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious from *Montgomery* in view of *Karbowski* should be withdrawn.

Amended independent claims 24, 47, and 70, although different in scope, contain similar recitations as those discussed above regarding amended claim 1. For at least the reasons discussed above with regard to claim 1, the Final Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claims 24, 47, and 70, these independent claims are allowable, and Applicant respectfully requests the Examiner withdraw the section 103 rejections of these claims.

Furthermore, because a *prima facie* case of obviousness has not been made for independent claims 1, 24, 47, and 70, a *prima facie* case of obviousness has also not been established for claims 2-16, 18-23, 25-39, 41-46, 48-62, 64-69, 71-85, and 87-92, by virtue of their dependence on the independent claims. Thus, dependent claims 2-16, 18-23, 25-39, 41-46, 48-62, 64-69, 71-85, and 87-92, are allowable at least by virtue of their dependence from allowable independent claims, as well as by reason of reciting additional elements not taught or suggested by the cited references. Accordingly,

Applicant respectfully requests the Examiner withdraw the rejection of claims 1-16, 18-39, 41-62, 64-85, and 87-92 under 35 U.S.C. § 103(a) and allow the pending claims.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application, withdrawal of the claim rejections, and the timely allowance of pending claims 1-16, 18-39, 41-62, 64-85, and 87-92.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 4, 2011

By: /Melanie Grover/
Melanie Grover
Reg. No. 63,599